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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,130	04/24/2001	Isao Nishimura	206525US0	4417

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EXAMINER

HAMILTON, CYNTHIA

ART UNIT PAPER NUMBER

1752

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/840,130

Applicant(s)

NISHIMURA ET AL. 

Examiner

Cynthia Hamilton

Art Unit

1752

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: SEE ATTACHMENT.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Note: ATTACHMENT
ENCLOSED

CYNTHIA HAMILTON
PRIMARY EXAMINER



Cynthia Hamilton
Primary Examiner
Art Unit: 1752

94
2-12-04**ATTACHMENT**

Continuation of NOTE under 2 :

The amendment does not overcome the only prior art of record and the wording changes in the claim raise new issues of clarity with respect to 35 USC 112, second paragraph. The changing of the scope of alkali soluble resin raises issues of new matter as well as further consideration. The presence of the volatile compound is not clearly required by the change in language. It is unclear whether its presence is optional or not with the proposed wording. The examiner notes that applicants interpret the wording of their claims to require that an epoxy group containing monomer be part of the "copolymer of at least...". The claim language of claim 1 does not require the epoxy group in this copolymer. The epoxy group containing compound is only one of three required compounds that are "at least" part of the copolymer. The copolymer must be of at least one unsaturated carboxylic monomer, an epoxy group-containing compounds and another olefinic unsaturated compound as proposed by applicant's amendment. The assumption made by the examiner here is "of" refers to the copolymer being made from these three compounds since a monomer is clearly not a copolymer. The only monomer required by this language is the unsaturated carboxylic monomer. There is no requirement that the resultant copolymer have an epoxy group. There is no requirement that the epoxy group containing compound and the olefinic unsaturated compound be copolymerized with the unsaturated carboxylic monomer. Applicant's interpretation of this language raises the issue of confusion with respect to the amendment presented. The amendment does not clearly remove Tanamura et al as a reference either. The binder of Tanamura et al in Example 1 could have been made from an epoxy group containing unsaturated compound as evidenced by the fourth mer in the polymer.

This fourth mer could have been made after copolymerization by the reaction of an acid group and an epoxy group-containing ethylenically unsaturated compound as evidenced by the remaining hydroxy group on the carbon ring located where an epoxy ring would have opened to form the fourth mer in Example 1 of Tanamura et al. The instant copolymer at issue is claimed in a product-by-process manner is part of a process used to claim a barrier rib by a product-by-process manner. Thus, issues are raised by applicants' arguments with respect to the meaning of the claim language proffered and issues with respect to the prior art are not removed by the amendment while new issues with respect to the prior art are presented. The final is maintained and applicants' amendment is not entered. With respect to claim 6 and the optical density value, applicants have not shown the Tanamura et al examples do not have this required value inherently.

Cynthia Hamilton

February 12, 2004

CYNTHIA HAMILTON
PRIMARY EXAMINER